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EXAMINER

RECEK, JASON D

ART UNIT	PAPER NUMBER
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2442

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/530,759	Applicant(s) LEPPANEN ET AL.	
	Examiner JASON RECEK	Art Unit 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the pre-appeal conference decision mailed on May 5th 2010.

Status of Claims

Claims 1-31 are pending.

Response to Arguments

1. The declaration filed on February 12th 2010 under 37 CFR 1.131 is sufficient to overcome the Sylvain US 2004/0062383 A1 reference. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Xu et al. US 2003/0110228 A1.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claim 27, it is a method claim. Although the machine or transformation test is not the sole determination whether the

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subject matter is patent eligible, it provides a useful tool. In this case the claim does not meet the particular machine or transformation test. There is no clear indication the method is not directed to an abstract idea, in fact the steps claimed could be performed by hand or on paper thus suggesting the process may be an abstract idea. Therefore, the claim is rejected as being drawn to an abstract idea. Claims 28-29 do not cure this deficiency and therefore are also rejected based on their dependency.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 uses “means for” language and thus invokes 112 paragraph six. For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor. The written description of the specification must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm that performs the claimed function. Applicant may express the algorithm in any understandable terms

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including as a mathematical formula, in prose, in a flow chart, or in any other manner that provides sufficient structure (see MPEP 2181). In this case, no corresponding algorithm is disclosed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 and 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal US 2002/0083127 A1 in view of Xu et al. US 2003/0110228 A1.

Regarding claim 1, Agrawal discloses “a presence information unit configured to provide presence information” as a presence server that contains presence information about users (pg. 2 paragraph 24, Fig. 1), “said presence information comprising a plurality of elements” as presence data may indicate multiple conditions (pg. 2 paragraph 25), “a storing unit configured to store information defining at least one group, said group containing a plurality of users” as a buddy list (pg.2 paragraph 26), “an information providing unit configured to provide second information defining for each user of said group which elements of said presence information are to be provided to a watcher” as configuring user presence data to indicate specific states for certain users

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(pg. 4 paragraphs 41, 49), the watcher is the person to whom the presence information is provided, and “said second information defines a subset of said elements of said presence information” as providing certain presence information but not all presence information (paragraphs 41, 49).

Agrawal does not explicitly disclose “wherein said second information is definable by the watcher” however this is taught by Xu as a watcher module that allows a user to specify what information it would like it receive (paragraph 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal to include a watcher module as taught by Xu for the purpose of providing relevant information. The purpose of presence information is to inform the requester (watcher) of the availability of the first user (paragraph 3). A watcher may not be interested in the entirety of information but rather would prefer only to be updated when necessary (paragraph 37). Thus Xu suggests using rules (i.e. watcher module) to increase efficiency of presence updates (paragraph 33).

Regarding claim 2, Agrawal discloses “said defined subsets of said presence information are provided to the watcher” as providing presence data from the server to the client (pg. 3 paragraph 39, Fig. 4).

Agrawal does not explicitly disclose “in response to a request from said watcher” however this is taught by Maanoja as a user requesting presence information (paragraph 45).

Regarding claim 3, Agrawal discloses “wherein said watcher is at least one of said plurality of said users” as a user who configures their buddy list to show presence data of others is a requester of that data (pg. 2 paragraph 26).

Regarding claim 4, Agrawal discloses “said defined subsets of said elements of said presence information are available only to one watcher or to a plurality of watchers” as controlling who has access to presence information (pg. 4 paragraph 49).

Regarding claim 5, Agrawal discloses “said defined subsets of said elements of said information provided are dependent on the identity of the watcher” as only showing presence information to certain people (pg. 4 paragraph 49).

Regarding claim 6, Agrawal discloses “a determining unit configured to determine the identity of the watcher making said request” as a buddy list user would necessary know the identity of the other users receiving the presence information (pg. 4 paragraph 41).

Regarding claim 7, Agrawal discloses “said storing unit comprises a presence server” as a presence server (pg. 2 paragraph 24, Fig. 1).

Regarding claim 8, Agrawal discloses “said information providing unit ... comprises a storage means” as an application server having a presence repository (pg. 4 paragraph 42, Fig. 11).

Regarding claim 9, Agrawal discloses “said storing unit and said information providing unit are provided by a common storage unit” as a presence server and an application server that have access to a common presence repository (pg. 4 paragraph 41-42, pg. 5 paragraph 53, Fig. 11).

Regarding claim 10, Agrawal discloses “said information providing unit ... comprises one of said users” as a user that provides presence information about himself (pg. 4 paragraph 49).

Regarding claim 11, Agrawal discloses “a separate address is provided for each of a plurality of groups” as using protocols HDTP/HDML or WAP or TCP/IP each message would have a unique address, thus each group would have a separate address (pg. 2 paragraphs 27-29).

Regarding claim 12, Agrawal discloses “said users comprise user equipment” as a client/user consisting of a mobile device (pg. 2 paragraph 24, Fig. 1).

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Regarding claim 13, Agrawal discloses “said presence information comprises at least one of the following elements of information: Subscriber status; Network status; communication means; Contact address, Subscriber provided location; Network provided location; text; priority; mood, favourite colour” as presence information includes at least network status – available or unavailable (pg. 2 paragraph 25) but may also include contact information and location (pg. 4 paragraph 41).

Regarding claim 14, Agrawal discloses “second information comprises information as to subsets of said the elements of said presence information required” as providing the presence information (pg. 2 paragraph 25, pg. 3 paragraph 39) which is configured from available presence information (paragraph 41), thus comprising a subset of information and only providing information which is allowed/required (paragraph 49).

Regarding claim 15, it corresponds to claim 14 but defines the second information subset as being the information that is not required. As discussed in claim 14, Agrawal discloses configuring a set of information (subset) that may or may not be required (paragraphs 49-50).

Regarding claim 16, Agrawal discloses “the subsets of said elements of the presence information to be obtained are the same for all of at least one group” as

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configuring a buddy list to identify who is available, thus the same information is provided for all of the group (pg. 4 paragraph 41).

Regarding claim 17, Agrawal discloses “the subsets of said elements of the presence information to be obtained are different for at least two users at least one group” as configuring a buddy list to identify who is available and configuring a buddy list to identify who is not available but reachable, thus different presence information is being obtained (pg. 4 paragraph 41).

Regarding claim 21, Agrawal discloses “said storing unit is arranged to receive presence information from the users of said group” as presence information is sent from the users to the server where it is stored (pg. 2 paragraph 25).

Regarding claim 22, Agrawal discloses “said storing unit is arranged to provide the parts of the presence information to be provided” as the server provides the presence information to other users (pg. 4 paragraph 41).

Regarding claims 23-24, Agrawal discloses “an entity associated with a user or a user of the group is arranged to provide to the elements of the presence information to be provided” and “said entity comprises a presence server” as a presence server associated with the users that provides presence information (pg. 2 paragraph 24, Fig. 1).

Regarding claim 25, Agrawal discloses “said storing unit is configured to add said elements of presence information to a request sent to said user or an entity associated with said user” as delivering an acknowledgment to the message originator concerning the user presence information (pg. 4 paragraph 44).

Regarding claim 26, Agrawal discloses “said storage unit receives from said requester, said storage unit is configured to insert the elements of presence information into a request sent to said user or an entity associated with said user” as an application where a user configures a buddy list to inform user presence data, thus the storage means is inserting the user presence data for the requester (pg. 2 paragraph 26, pg. 3 paragraph 39, pg. 4 paragraph 41).

Regarding claim 27, Agrawal discloses “defining at least one group containing a plurality of users with which presence information is associated, said presence information comprising a plurality of elements associated with each user” as a buddy list where users have presence information associated with them that comprises a plurality of parts (pg. 2 paragraph 26, pg. 4 paragraph 41), and “defining for each user of said group what elements of said presence information are to be provided to a watcher, wherein ... said provided information defines a subset of said elements” as specifying what presence information to receive (pg. 4 paragraph 41).

Agrawal does not explicitly disclose “wherein defining for each user of said group which elements of said presence information are to be provided is preferred by the watcher” however this is taught by Xu as a subscriber (i.e. watcher) indicating what information they are interested in (paragraph 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal to include a watcher module as taught by Xu for the purpose of providing relevant information. The purpose of presence information is to inform the requester (watcher) of the availability of the first user (paragraph 3). A watcher may not be interested in the entirety of information but rather would prefer only to be updated when necessary (paragraph 37). Thus Xu suggests using rules (i.e. watcher module) to increase efficiency of presence updates (paragraph 33).

Regarding claim 28, Agrawal discloses “filtering the presence information for at least one user of the group to obtain the defined elements of said presence information” as a user configuring what presence information to show and to whom, thus the presence information is “filtered” (pg. 4 paragraph 49).

Regarding claim 29, Agrawal discloses “requesting for at least one user of said group said defined elements of said presence information” as a user wanting to know the presence information of another user of a group (pg. 3 paragraph 39).

Regarding claim 30, Agrawal discloses “a storing unit ... defining at least one group, wherein said group comprises a plurality of users with which presence information is associated” as a buddy list that contains several users each user having presence information (pg. 2 paragraph 26), “said presence information comprises a plurality of elements” as presence information that comprises multiple parts (pg. 2 paragraph 25, pg. 4 paragraph 41), and “second information defining for each user of said group which elements of said presence information are to be provided to a watcher, wherein ... provided information defines a subset of said elements” as a user configuring what parts of presence information to provide (pg. 4 paragraphs 41, 49).

Agrawal does not explicitly disclose “wherein said second information is definable by the watcher” however this is taught by Xu as a subscriber (i.e. watcher) indicated what information they would like to receive (paragraph 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal to include a watcher module as taught by Xu for the purpose of providing relevant information. The purpose of presence information is to inform the requester (watcher) of the availability of the first user (paragraph 3). A watcher may not be interested in the entirety of information but rather would prefer only to be updated when necessary (paragraph 37). Thus Xu suggests using rules (i.e. watcher module) to increase efficiency of presence updates (paragraph 33).

Regarding claim 31, it corresponds to claim 1 except it contains the language “means for” in place of the term “unit” thus it is narrower in scope since it is limited to the

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examples described in the specification and therefore it is rejected for the same reasons given in claim 1.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Agrawal and Xu as applied to claim 1 above, and further in view of Bobde et al. US 2003/0217142 A1.

Regarding claim 18, the combination of Agrawal and Xu does not disclose “the system operates in accordance with a session initiation protocol (SIP)” however this is taught by Bobde (paragraph 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with SIP as taught by Bobde. SIP is well known in the art (as evidenced by Bobde) and yields predictable results. Therefore, this is merely the combination of known elements according to their established function in order to yield a predictable result.

Regarding claim 19, the combination of Agrawal and Xu does not disclose “request for said presence information is made in a SUBSCRIBE request” however this is taught by Bobde (paragraph 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal and Xu with SIP as taught by Bobde. SIP is well known in the art (as evidenced by Bobde) and yields predictable results. Therefore, this is merely the combination of known elements according to their established function in order to yield a predictable result.

Regarding claim 20, the combination of Agrawal and Xu does not disclose “the information providing unit comprises a SIP SUBSCRIBE message” however this is taught by Bobde (paragraph 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal and Xu with SIP as taught by Bobde. SIP is well known in the art (as evidenced by Bobde) and yields predictable results. Therefore, this is merely the combination of known elements according to their established function in order to yield a predictable result.

8. Claims 1-31 provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/804600 (Lonnfors US 2004/0177134) which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C.

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103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Fri 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached on (571) 272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Recek/
Examiner, Art Unit 2442
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/Philip C Lee/
Acting SPE of Art Unit 2442

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